

## REMARKS

### *Status of the Claims*

Claims 51 and 53-59 are pending in the application, with Claims 51, 54, 57 and 58 being independent. Claims 51, 54, 57 and 58 have been amended. Claim 59 has been added. Support for the new claim and claim changes can be found in the original disclosure, and therefore no new matter has been added.

### *Requested Action*

Applicant respectfully requests the Examiner to reconsider and withdraw the outstanding rejections in view of the foregoing amendments and the following remarks.

### *Claim Rejections*

Claims 51, 54, 55, 57, and 58 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,618,553 (Shiohara) in view of U.S. Patent No. U.S. Patent No. 5,442,687 (Miller) and U.S. Patent No. 6,930,717 (Kobayashi et al.). Claims 53 and 56 are rejected under 35 U.S.C. §103(a) as being unpatentable over the citation to Shiohara in view of the citations to Miller, Kobayashi et al., and U.S. Patent No. 6,563,542 (Hatakenaka).

In response, while not conceding the propriety of the rejections, independent Claims 51, 54, 57, and 58 have been amended. Applicant submits that as amended, these claims are allowable for the following reasons.

Claim 51 relates to an image pickup apparatus comprising an image pickup unit for obtaining a digital image, an interface for connecting to a storage medium which stores the digital image obtained by the image pickup unit, a reproducing unit for reading out the digital

image stored in the storage medium via the interface and causing a display apparatus to display the read-out image, an operation unit for effecting a changeover operation of an image to be displayed on the display apparatus, a single manually operable designating unit for designating the image displayed on the display apparatus as a print subject for an external printer communicating with the image pickup apparatus, a display control unit, and a printing control unit.

Claim 51 has been amended to recite that the display control unit is for, if the single manually operable designation unit provides a first designation after the image pickup apparatus is connected with the external printer, controlling the display apparatus so as to display a print setting screen for displaying a predetermined print condition and a temporarily selected menu for instructing execution of a printing operation so that the displayed print condition is selectable in accordance with operations of the single manually operable designation unit and another operation unit comprising an operation button and the print setting screen indicates that the predetermined print condition displayed thereon is selected as a default selection to execute printing of the image displayed by the display apparatus.

Claim 51 has also been amended to recite that the printing control unit is for instructing the external printer to print the image displayed by the display apparatus, in accordance with the single manually operable designating unit providing a designation after the print setting screen is displayed.

Claim 51 has further been amended to recite that the print control unit instructs the execution of the print operation based on the default selection of the predetermined print condition to the external printer if the single manually operable designation unit provides a

second designation successively to the first designation without interposing any other manual operation by the another operation unit between the first and second designations.

By this arrangement, since a print setting screen (*e.g.*, the non-limiting example of Fig.12) can be displayed in accordance with a first designation of a single manually operable designating unit (*e.g.*, the non-limiting example of a “set” button) to display a predetermined print condition and a temporarily selected menu for instructing execution of a printing operation so that the displayed print condition is selectable in accordance with operations of the single manually operable designation unit and another operation unit comprising an operation button and the print setting screen indicates that the predetermined print condition displayed thereon is selected as a default selection to execute printing of the image displayed by the display apparatus, a user can recognize that printing will be executed only if the user makes the second designation without requiring any other manual operation between the first and second designations of the single manually operable designation unit. In addition, the user also can change the print condition before providing the second designation according to occasional demand, so that user can avoid printing based on the undesired printing condition.

In contrast, the citations to Shiohara, Miller, and Kobayashi are not understood to disclose or suggest a display control unit for, if the single manually operable designation unit provides a first designation after the image pickup apparatus is connected with the external printer, controlling the display apparatus so as to display a print setting screen for displaying a predetermined print condition and a temporarily selected menu for instructing execution of a printing operation so that the displayed print condition is selectable in accordance with operations of the single manually operable designation unit and another operation unit comprising an operation button and the print setting screen indicates that the predetermined print

condition displayed thereon is selected as a default selection to execute printing of the image displayed by the display apparatus, as recited by amended Claim 51. Therefore, these citations are also not understood to disclose or suggest a printing control unit for instructing the external printer to print the image displayed by the display apparatus, in accordance with the single manually operable designating unit providing a designation after the print setting screen is displayed, and for instructing the execution of the print operation based on the default selection of the predetermined print condition to the external printer if the single manually operable designation unit provides a second designation successively to the first designation without interposing any other manual operation by the another operation unit between the first and second designations, as also recited by amended Claim 51.

The Office Action refers to the Shiohara citation to argue that the selective use of buttons 17 and 18 in this citation teach printing in accordance with successive first and second designations of a single manually operable designation unit. But Applicant understands this citation to disclose that the buttons 17 and 18 have the same function and that one of them must be requested to be operated in each of the steps S3, S5, S6, S7 and S8, so that the user will be eventually requested to selectively operate the buttons 17 and 18 a plurality of times corresponding to the number of the steps S3, S5, S6, S7 and S8. In addition, each step is understood to require using buttons 19 and 20 to select a print condition item. Therefore, the menu screen shown in the Shiohara citation is understood to fail to teach a print setting screen for displaying a predetermined print condition and a temporarily selected menu for instructing execution of a printing operation so that the displayed print condition is selectable in accordance with operations of the single manually operable designation unit and another operation unit comprising an operation button and the print setting screen indicates that the predetermined print

condition displayed thereon is selected as a default selection to execute printing of the image displayed by the display apparatus, as recited by amended Claim 51. Therefore, this citation is also not understood to disclose or suggest a display control unit for, if the single manually operable designation unit provides a first designation after the image pickup apparatus is connected with the external printer, controlling the display apparatus so as to display a print setting screen for displaying a predetermined print condition and a temporarily selected menu for instructing execution of a printing operation so that the displayed print condition is selectable in accordance with operations of the single manually operable designation unit and another operation unit comprising an operation button and the print setting screen indicates that the predetermined print condition displayed thereon is selected as a default selection to execute printing of the image displayed by the display apparatus, as also recited by amended Claim 51.

The citation to Miller is understood to disclose a facsimile apparatus which is arranged to display “PRINT REPORT (1-4)” and “1: LAST TRANSACTION” (column 4 lines 42-45) when a report key 74 is depressed first, and to print the last transmission report when the report key 74 is depressed a second time. However, this reference is understood to be directed to a facsimile apparatus and therefore is understood to be silent on the relationship between reproduction and the selection of an image to be printed and the print setting screen for instructing to execute printing of such an image to a printer. That is, the citation to Miller is understood to fail to teach displaying the print condition of the selected image to instruct the external printer to print the selected image in accordance with the first and second designations (e.g., operations of the report key 74) being successively provided. Therefore, the citation to Miller is not understood to disclose or suggest the display control unit or the printing control unit recited by amended Claim 51.

The citation to Kobayashi was cited to show a default menu, which is understood to switch between an image reproduction mode and print condition setting (SETUP) using a mode dial 20. Specifically, when a user wishes to print an image, the mode dial 20 is understood to be set to the reproduction mode to display a frame image the user wishes to print on a liquid crystal display 19, and then a print key 24 is understood to be operated while the image is being displayed on the display 19. That is, printing is understood to be executed by one operation of the print key after the image to be printed is reproduced (selected) without displaying a print condition setting. In this connection, it should be noted that the print setting screen, which is referred to in the Office Action, is understood to be included in a SETUP menu screen which is displayed at a timing unrelated to print instruction processing (column 4, lines 61-67, and column 5, lines 1-7). In addition, the citation to Kobayashi is understood to teach a “default print number 1” (*e.g.*, column 5, line 53), but the menu (Fig.5B) is understood to fail to include a print execution menu which can be selected as a default, so that this reference is not understood to instruct the execution of printing from a print condition setting menu. Therefore, this citation is not understood to disclose or suggest the display control unit is for, if the single manually operable designation unit provides a first designation after the image pickup apparatus is connected with the external printer, controlling the display apparatus so as to display a print setting screen for displaying a predetermined print condition and a temporarily selected menu for instructing execution of a printing operation so that the displayed print condition is selectable in accordance with operations of the single manually operable designation unit and another operation unit comprising an operation button and the print setting screen indicates that the predetermined print condition displayed thereon is selected as a default selection to execute printing of the image displayed by the display apparatus, as recited by amended Claim 51.

Since the citations to Shiohara, Miller, and Kobayashi are not understood to disclose or suggest at least two features of amended Claim 51, Applicant submits that the Office has not yet satisfied its burden of proof to establish a prima facie case of obviousness against amended Claim 51. Therefore, Applicant respectfully requests that the rejection of amended Claim 51 be withdrawn.

And because independent Claims 54, 57 and 58 are corresponding method, program and medium claims, respectively, and have been now amended in a similar manner to the amended Claim 51, the Office has not satisfied its burden of proof to establish a prima facie case of obviousness against amended Claims 54, 57, and 58. Therefore, Applicant respectfully requests that the rejection of Claims 54, 57, and 58 be withdrawn.

The dependent claims are also submitted to be patentable, due to their dependency from the independent base claims, as well as due to additional features that are recited. Individual consideration of the dependent claims is respectfully solicited.

### *Conclusion*

In view of the above amendments and remarks, the application is now in allowable form and entry of this Amendment is proper. Therefore, early passage to issue is respectfully solicited.

Any fee required in connection with this paper should be charged to Deposit Account No. 06-1205.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

/Gary M. Jacobs/

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Gary M. Jacobs  
Attorney for Applicant  
Registration No. 28,861

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200  
GMJ

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